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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,477	07/01/2003	Satoshi Endo	2003_0902A	2228

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EXAMINER	
DINH, TAN X	

ART UNIT	PAPER NUMBER
2627	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/609,477	ENDO ET AL.	
	Examiner	Art Unit	
	TAN X. DINH	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-23 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1) Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

2) The I.D.S filed 5/13/2004 and 12/15/2003 have been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested:

HIGH SPEED RECORDING AND REPRODUCING FOR OPTICAL DISK DEVICE OF DIFFERENT FORMAT.

4) The abstract of the disclosure is objected to because the abstract is unclean and cannot be understood with phrases "Sjr", " Ssbis", etc.,. Correction is required. See MPEP § 608.01(b).

5) Claims *1-23* are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase " normal replay speed " (claims 1 and 10, line 4) is indefinite because the read out speeds in the recording art could

all be considered to be conventional, standard or normal speed.

The same rejection is applied to the phrase " maximum replay speed " of claims 10.

Claim(s) 2-9,11-23 incorporate the indefiniteness of claim(s) 1 and 10 by virtue of their dependency thereon.

6) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> 7) (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8) Claims *10-14,16 and 17*, as understood by the meaning of 112, 2nd above, are rejected under 35 U.S.C. 102(e) as being anticipated by KONDO (US 6,388,959).

KONDO discloses a high speed recording and reproducing apparatus as claimed in claim 10, which reads data from a first optical disk having recorded thereon first digital data to be reproduced at a first replay speed as being a normal replay speed, at a second replay speed higher than the first replay speed, reproduces the read data as second digital data, and records the

reproduced second digital data in the second writable optical disk (Fig.2, CD 91 is recorded under CLV which includes first normal play speed and second higher play speed, the information data from CD 91 is recorded to rewritable optical disk 90 (MD)), the apparatus comprising:

maximum replay speed detecting means for detecting, based on a piece of the second digital data reproduced from a predetermined portion of a recording area of the first optical disk, a maximum replay speed applicable to an entire recording area of the first optical disk (column 17, lines 45-59. In this case, the detecting signal DT detects the tracks of maximum play speed);

optical disk replaying means for reproducing the second digital data from the first optical disk at the maximum replay speed (column 17, lines 45-59. In this case, the digital data (audio tracks) are reproduced as double speed); and

optical disk recording means for recording the second digital data on the second optical disk (Fig.2, MD 90. The audio signals from CD 91 are recorded to MD 90 by MD controller 11).

As to claims 11-14, KONDO shows a predetermined portion is a portion which is typically defined based on a type of the first optical disk and in which reproduction defects tend to occur most during replaying of the first optical disk at the second replay speed (column 19, lines 54-65).

As to claims 16 and 17, since the first optical disk of KONDO is CD which is the same as applicant's optical disk, it inherently has the same structures and/or function as applicant's optical disk.

9) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11) Claims *15,18-20*, as understood by the meaning of 112, 2nd above, are rejected under 35 U.S.C. 103(a) as being unpatentable over KONDO (US 6,388,959).

KONDO discloses all the subject matter as claimed in claims 15,18-20, *except that* the optical disk is recorded as CLV scheme *rather than* ZCAV scheme. Official Notice is taken that the method of using ZCAV scheme are widely used in the art for recording information data to an optical disk, and therefore they are old and well known. It would have been obvious to use the old and well known ZCAV scheme in an optical disk such as KONDO's because, in the absence of any new or unexpected result, selecting of a known method for format based on its suitability for the intended use is deem obvious. In re LESHIN, 125 USPQ 416.

12) Claims *1-9* would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

13) Claims *21-23* would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the *patentable novelty must be clearly shown* in view of the

state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments *avoid* such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

15) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN Xuan DINH whose telephone number is (571)-272-7586. The examiner can normally be reached on MONDAY-FRIDAY from 8:00AM to 5:30PM.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TAN DINH
PRIMARY EXAMINER
August 10, 2006